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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* WILLIAM SCHMID and  
ARETE MARTHA PASSAS

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Appeal 2012-002155  
Application 11/820,364  
Technology Center 3700

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Before: STEFAN STAICOVICI, NEIL T. POWELL, and  
BEVERLY M. BUNTING, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 19 and 24–28. We have jurisdiction under 35 U.S.C. § 6(b).

### THE CLAIMED SUBJECT MATTER

Independent claim 19, reproduced below, is illustrative of the appealed subject matter.

19. A method of communicating information concerning the sleep position of an infant to the infant's caregiver, the method comprising:

providing information pertaining to the sleep position of the infant on an exterior surface of a front of infant sleep garment that is designed to be worn by the infant when sleeping, with the information pertaining to sleep position being disposed on the exterior surface, wherein the information is lettering that is provided on the exterior surface of the front of the infant sleep garment so as to be integrally attached to the exterior surface, the lettering includes a plurality of letters and the word back, and the sleep position suggested by the information is that the infant should sleep on his or her back.

### REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

O'Hara	US 2,374,299	Apr. 24, 1945
Asher	US 2,399,782	May 7, 1946
Metzger	US 4,530,349	July 23, 1985
Kirsch	US 4,928,831	May 29, 1990

## REJECTIONS

Appellants seek our review of the following rejections:

I. Claims 19 and 24–28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

II. Claims 19 and 24 stand rejected under 35 U.S.C. § 102(b) as anticipated by Metzger.

III. Claim 25 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Metzger and Asher.

IV. Claim 26 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Metzger and O’Hara.

V. Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Metzger, O’Hara, and Kirsch.

## ANALYSIS

### *Rejection of Claims 19 and 24–28 under § 101*

In *Alice Corp. Pty. Ltd. V. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court explained the test for determining whether a claim is directed to patent-ineligible subject matter as follows:

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. —, 132 S.Ct. 1289, 182 L.Ed.2d 321 (2012), we set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. *Id.*, at —, 132 S.Ct., at 1296–1297. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at —, 132 S.Ct., at 1297. To answer that question, we consider the elements of each claim both individually and “as an ordered

combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. *Id.*, at —, 132 S.Ct., at 1298, 1297. We have described step two of this analysis as a search for an “ ‘inventive concept’ ”—i.e., an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.*, at —, 132 S.Ct., at 1294.

*Alice*, 134 S.Ct. at 2355.

In rejecting claims 19 and 24–28 under 35 U.S.C. § 101, the Examiner asserts that Appellants’ claims “are attempting to patent an abstract idea in the form of ‘providing’ information.” Ans. 12. The Examiner states that the claims are directed to the “general concept” of a “method of communicating information concerning the sleep position of an infant to the infant’s caregiver.” *Id.* at 5.

Appellants argue that the claims do not attempt to generally claim communicating infant sleep position. App. Br. 12. Rather, Appellants argue, the claimed methods of communicating infant sleep position are tied to a particular structure, specifically an infant sleep garment. *Id.* Thus, Appellants argue, the claims do not preclude a number of other ways to communicate infant sleep position. *Id.*

The Examiner responds that the claim limitations related to the infant sleep garment should “impose[] a meaningful limitation on the claim’s scope,” implying that the claims recite the infant sleep garment in a way that does not impose a meaningful limitation on the claims. Ans. 11.

Appellants’ arguments apprise us of error in the Examiner’s rejection. Each of the rejected claims positively requires an infant sleep garment. Independent claim 19 recites “providing information pertaining to the sleep

position of the infant on an exterior surface of a front of an infant sleep garment.” This action cannot be executed without an infant sleep garment; thus, independent claim 19 is limited to using an infant sleep garment to perform the claimed method of communication. Independent claim 27 recites “providing an infant sleep garment,” thereby also requiring the use of an infant sleep garment in the method. Dependent claims 24–26 and 28 are likewise limited to using an infant sleep garment because each of dependent claims 24–26 and 28 depends from independent claim 19 or independent claim 27.

Because the rejected claims are limited to using the specific structure of an infant sleep to perform the method of communicating, we agree with Appellants that the claims do not preclude a number of other methods of communicating infant sleep position. App. Br. 12. Accordingly, even if we accept, *arguendo*, the Examiner’s contention that communicating infant sleep position constitutes an abstract idea, the claims include “additional features” that ensure the claims are “more than a drafting effort designed to monopolize the [abstract idea].” *Alice*, 134 S. Ct. at 2357. Consequently, we do not sustain the Examiner’s rejection of claims 19 and 24–28 under 35 U.S.C. § 101.

*Anticipation Rejection of Claims 19 and 24 and Obviousness Rejection of Claims 27 and 28<sup>1</sup>*

The Examiner finds that Metzger's vest 10 meets the recitation in claims 19 and 27 of "an infant sleep garment that is designed to be worn by the infant when sleeping." Ans. 6, 9. The Examiner notes that no structure prevents Metzger's vest 10 from being worn by an infant while sleeping. *Id.* at 6, 9.

Appellants assert that Metzger's vest 10 is not an infant sleep garment, and that there is no indication that Metzger's vest 10 should be used as an infant sleep garment. App. Br. 13, 15. Appellants note that Metzger discloses a patient wearing vest 10 during therapy sessions that involve "thumping" the patient. *Id.* Appellants argue that a patient likely could not sleep during such treatment. *Id.* Additionally, Appellants argue that there is no indication that vest 10 is designed to be worn during sleep, and that "[w]hether or not the vest is worn at times other than during treatment is a matter of pure speculation not supported by the Metzger disclosure." *Id.*

The claim language "an infant sleep garment that is designed to be worn by the infant when sleeping" recites a function and/or intended use for the garment required by the claims, specifically the function or intended use of being worn by an infant while sleeping. Functional language in a claim does not impart patentability if prior art structure has the capability to function in the recited manner. *In re Schreiber*, 128 F.3d 1473, 1477–78

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<sup>1</sup> Appellants' arguments regarding these two rejections raise the same substantive issues regarding whether Metzger discloses or teaches certain language in claims 19 and 27. Accordingly, we discuss these rejections together.

(Fed. Cir. 1997). Likewise, the recitation in a claim of a new intended use for an old structure does not impart patentability to the claim. *Id.* at 1477. The Examiner reasonably finds that an infant could wear Metzger's vest 10 while sleeping, noting that no structural aspect of vest 10 would prevent an infant from wearing it while sleeping. Ans. 6, 9. Appellants provide no persuasive reason to doubt this finding. Accordingly, Appellants' arguments do not apprise us of error in the Examiner's finding that Metzger discloses "an infant sleep garment that is designed to be worn by the infant when sleeping."

Appellants also argue that, contrary to the Examiner's finding, Metzger does not disclose "providing information pertaining to the sleep position of the infant," which is recited in claim 19. App. Br. 14. Similarly, Appellants argue that Metzger does not disclose lettering that includes the word "back," as recited in claims 19 and 27. *Id.* at 14–15.

In support of a finding that Metzger discloses these recitations of claims 19 and 27, the Examiner cites identifier 18 of Figure 1A; Figure 6; column 5, lines 37–40; and column 4, lines 18–24 of Metzger. Ans. 6, 9. At column 4, lines 18–24, Metzger discloses:

FIG. 6 shows a treatment for the upper lobes, anterior segments: 2. The infant is placed on his back over a pillow on a therapist's lap. The therapist claps between the clavicle (collarbone) and the nipple on each side of chest, i.e. over patches "2" on the vest 10. The arrows in patches 2 point horizontally to indicate that the infant is lying horizontally.

In column 5, lines 37–39, Metzger discloses that "written instructions could be substituted for the arrows." Regarding these portions of Metzger, the Examiner asserts that "[i]f the therapy aids were replaced with written



instructions [then] the word ‘back’ would be provided on the front of the infant garment, because the instructions for figure 6, as provided in column 4, lines 18-24, detail instructions that the infant is placed on his **back** over a pillow.” Ans. 14.

Appellants argue that the information presented on Metzger’s garment conveys treatment positions, not sleep positions, i.e., not information pertaining to the sleep position of the infant. App. Br. 14, 15. Additionally, Appellants argue that the Examiner errs in asserting that Metzger’s disclosure of replacing arrows with words would result in using the word “back” on Metzger’s garment. *Id.* at 14, 16. In support of this position, Appellants assert that replacing arrows with words would not necessarily involve using the word back. *Id.* Instead, Appellants argue, “[t]he written instructions disclosed by Metzger could say ‘place patient face up’ or ‘place patient in supine position’ each of which would result in the patient being on his back without actually using the word ‘back.’” *Id.*

Appellants’ arguments do not apprise us of error because the claim language “information pertaining to the sleep position of the infant” and “the lettering includes a plurality of words and the word back” recites nonfunctional descriptive matter. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (noting that when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability); *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (“[T]he relevant question is whether ‘there exists any new and unobvious functional relationship between the printed matter and the substrate.’”) (citations omitted).

Claims 19 and 27 recite that the information appears on an infant sleep garment. The infant sleep garment would serve its function of covering and protecting the infant without the recited information. Additionally, the information can serve its function of communicating the sleep position without the infant sleep garment. For example, the information could serve its purpose of communicating the sleep position if one provided the information on a note attached to the infant's crib. *See* App. Br. 12. Because no functional relationship exists between the information (the information pertaining to the sleep position of the infant and the word back) and the substrate (the infant sleep garment) recited in the claims, the information recited in the claims constitutes nonfunctional descriptive matter that does not impart patentability.

Because our reasoning differs slightly from the Examiner's, we designate our affirmance of the anticipation rejection of claims 19 and 24 and our affirmance of the obviousness rejection of claims 27 and 28 as new grounds of rejection. And we modify these rejections with the above explanation that the claim limitations "information pertaining to the sleep position of the infant" and "the lettering includes a plurality of words and the word back" recite nonfunctional descriptive matter that does not impart patentability.

#### *Obviousness Rejections of Claims 25 and 26*

The Appeal Brief indicates that the grounds of rejection to be reviewed on appeal include the Examiner's rejections of claims 25 and 26 under 35 U.S.C. § 103. App. Br. 8. The Appeal Brief does not, however, include any substantive discussion of these rejections. *See id.* at 9–16.

Accordingly, we affirm the rejections of claims 25 and 26 under 35 U.S.C. § 103. We designate our affirmance of the obviousness rejections of claims 25 and 26 new grounds of rejection. Claims 25 and 26 depend from independent claim 19. As we explained in affirming the anticipation rejection of claim 19, the claim 19 language “information pertaining to the sleep position of the infant” and “the lettering includes a plurality of words and the word back” recite nonfunctional descriptive matter that does not impart patentability.

### DECISION

We reverse the Examiner’s decision rejecting claims 19 and 24–28 under 35 U.S.C. § 101.

We affirm the Examiner’s decision rejecting claims 19 and 24 under 35 U.S.C. § 102(b) as anticipated by Metzger. We designate our affirmance of the Examiner’s rejection of claims 19 and 24 under 35 U.S.C. § 102(b) as anticipated by Metzger a new ground of rejection.

We affirm the Examiner’s decision rejecting claim 25 under 35 U.S.C. § 103(a) as unpatentable over Metzger and Asher. We designate our affirmance of the rejection of claim 25 under 35 U.S.C. § 103(a) as unpatentable over Metzger and Asher a new ground of rejection.

We affirm the Examiner’s decision rejecting claim 26 under 35 U.S.C. § 103(a) as unpatentable over Metzger and O’Hara. We designate our affirmance of the rejection of claim 26 under 35 U.S.C. § 103(a) as unpatentable over Metzger and O’Hara a new ground of rejection.

We affirm the Examiner’s decision rejecting claims 27 and 28 under 35 U.S.C. § 103(a) as unpatentable over Metzger and Kirsch. We designate

our affirmance of the Examiner's rejection of claims 27 and 28 under 35 U.S.C. § 103(a) as unpatentable over Metzger and Kirsch a new ground of rejection.

### FINALITY OF DECISION

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) provides "Appellant[s] may file a single request for rehearing within two months of the date of the original decision of the Board." In addition to affirming the Examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)

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